

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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| IN RE APPLICATION OF | : |
| TOMOSHIGE UMEDA, ET AL. | : EXAMINER: BASICHAS, A. |
| SERIAL NO: 09/783,548 | : |
| FILED: FEBRUARY 15, 2001 | : GROUP ART UNIT: 3749 |
| FOR: MASK | : |

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The present Reply Brief is in response to the Examiner's Answer of May 19, 2004. Appellants respectfully reiterate that the basis for the outstanding rejection set forth in the Examiner's Answer of May 19, 2004 is improper and must be REVERSED.

The outstanding rejection, discussed in detail in the Appeal Brief filed March 12, 2004 is based upon the position that the teachings of Daneshvar (U.S. Pat. No. 5,205,282) are properly combinable with Mitra (U.S. Pat. No. 5,890,486). However, Appellants respectfully submit that this is not the case.

More specifically, Appellants respectfully submit that the teaching or suggestion to make the claimed combination and the reasonable expectation of success is found only in the Appellants' disclosure, and not in the prior art references. Daneshvar is related to a therapeutic nasal inhaler. In the therapeutic nasal inhaler of Daneshvar, vapor is generated and delivered for *inhalation* in contact with the nasal passages. As admitted in the Office Action of September 12, 2003, Daneshvar does not recite the heat-generating unit being by

exothermic chemical reaction having salt water and metal, and including oxidation.¹ The Office Action attempts to remedy this admitted deficiency by relying upon Mitra. However, Mitra describes a nasal dilator – a device which *mechanically expands* the nasal passages by application of an external force – further having a thermal element which *does not generate a vapor for inhalation* in contact with the nasal passages.

Therefore, the rationale for the combination cannot be found within the references' teachings. Thus, the final Office Action appears to rely upon the knowledge generally available to one of ordinary skill in the art as providing the motivation to combine the references teachings. However, the level of skill in the art cannot be relied upon to provide a suggestion to combine references.²

Moreover, Advisory Actions issued by the Examiner on December 11, 2003 and December 30, 2003 failed to address the limitations recited in the claims as filed in the Amendment of December 3, 2003, despite entry of this amendment. The newly added claim limitations were never substantively addressed by the Examiner relative to the cited references during prosecution of this application. Accordingly, it is respectfully submitted that the pending claims patentably distinguish over the applied combination of Danishvar and Mitra based on the present record in this case.

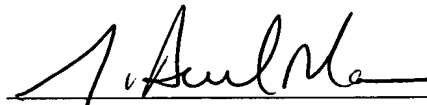
¹ Office Action, September 12, 2003, page 3, paragraph 5.

² Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Therefore, for at least the foregoing reasons, Appellants respectfully submit that the outstanding rejection must be REVERSED.

Respectfully submitted,

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